

REMARKS/ARGUMENTS

Amendments and Status

Before this Amendment, claims 1-9, 11-12, 15-20, 23-31, 33-36, 41-50, 67, and 74-78 were present for examination. Claims 1, 23, 31, 35, and 36 are amended. Therefore, claims 1-9, 11-12, 15-20, 23-30, 33-36, 41-50, 67, and 74-78 are present for examination, and claims 1, 12, 23, 31, 35, 36, and 67 are the independent claims. No new matter is added by these amendments. Applicants respectfully request reconsideration of this application as amended.

The Office Action dated June 7, 2006 ("Office Action") rejected claims 23, 24, 26, 28-30 and 35 under 35 U.S.C. §103(a) as unpatentable over the cited portions of Yen, U.S. 2002/0066789 A1 ("Yen") in view of the cited portions of Silverbrook et al., U.S. 2003/0086705 A1 ("Silverbrook"). The Office Action rejected claims 1-9, 11, 12, 15-20, 36, 41-50, 67 and 74-78 under 35 U.S.C. §103(a) as unpatentable over Yen as modified by Silverbrook and further in view of the cited portions of Biller, U.S. 2004/0182940 A1 ("Biller"). The Office Action rejected claims 31, 33 and 34 under 35 U.S.C. §102 as anticipated by the cited portions of Blank, U.S. Patent 7,032,817 ("Blank"). The Office Action rejected the remaining claims under 35 U.S.C. §103(a) as unpatentable over Yen and Silverbrook and further in view of other prior art.

35 U.S.C. §103(a) Rejection, Yen/Silverbrook

The Office Action rejected independent claims 23 and 35 under 35 U.S.C. §103(a) as unpatentable over Yen in view of Silverbrook. The Office Action further rejected independent claims 1, 12, 36, and 67 over Yen in view of Silverbrook and Biller. To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP §2143.

These cited references cannot be relied on to teach or suggest a number of limitations related to the live copy limits. The live copy comprises the "printed information on the front or back side of the card 10. For example, it may contain the name of the merchant issuing the gift card, such as Target®, Wal-Mart®, Starbucks®, Sears®, Blockbuster® or the value of the gift card, such as \$5, \$10, \$15, \$20, \$50, \$100, etc." (Original Application, p. 7, ll. 19-22;

FIG. 1A, Ref. Num. 20; Fig. 1B, Ref. Num. 26). It may also include printed information comprising "instructional information, promotional information, website address, sponsor logos, graphics, or a signature block" (*Id.*, p. 7, ll. 24-25). It clearly differs from the claimed information storage medium.

The Office Action concedes that the limitations related to the live copy limits are not disclosed in Yen (Office Action, p. 7, ll. 11-13). Instead, the Office relies on Silverbrook as teaching these limitations (*Id.*, p. 7, ll. 14-17). The Office appears to contend that the "border region 103" of the data surface comprises the live copy limit of the claims. But this clearly differs from the claims. The border region is simply the region between the array of active data blocks and the edge of the card or photograph. Silverbrook points out that "data dots" are different than "non-data dots." (Silverbrook, p. 3, ¶ [0065]). In fact, Silverbrook merely teaches that the border region 103 not contain *data dots*; there does not appear to be a requirement that the border region 103 be free of other imaging.

The claims clearly differ, as there is a distinction drawn between the information storage medium and the live copy. The independent claims will each be addressed in turn:

Claim 1: Claim 1 recites that "the live copy limit is within about 3/32 of an inch from an outside edge of the card." Clearly, Silverbrook cannot be relied upon to teach this limitation. Moreover, claim 1 recites at least a pair of apertures which are at least about 1/16 of an inch from the live copy limit. No such limitation is suggested by Silverbrook, as this reference does not suggest the apertures or live copy limits of the claims.

Claim 12: Claim 12 states that " the live copy limit is located on the front or back side of the card at about 3/32 of an inch from the top, bottom, and both side portions of the data card." As noted above, Silverbrook fails to teach the live copy limit of the claims. There is no suggestion in Silverbrook or the other cited references that a live copy limit be about *3/32 of an inch from the top, bottom, and both side portions* of the card.

Claim 23: Like claim 1, claim 23 recites that "the live copy limit is within about 3/32 of an inch from an outside edge of the card." Again, this is clearly not suggested by

Silverbrook's border between the array of data blocks and the edge of the card; the data block of Silverbrook differs from the live copy of the claim. Moreover, claim 23 calls for an aperture which is at least 1/16 of an inch from the live copy limit. Silverbrook does not suggest either the claimed aperture or the live copy limit, and thus cannot be relied upon to teach this limitation.

Claim 35: Like claim 23, claim 35 recites that "the live copy limit is within about 3/32 of an inch from an outside edge of the card," and also calls for an aperture which is "at least 1/16 of an inch from the live copy limit." Again, neither of these limitations are suggested by Silverbrook. Moreover, claim 35 recites a rectangular shaped aperture. Such an aperture is not taught or suggested by Silverbrook, nor is it suggested by the round aperture of Yen.

Claim 36: Claim 35 is a method claim which, like claim 35, recites that "the live copy limit is within about 3/32 of an inch from an outside edge of the card," and also sets forth an aperture which is "at least 1/16 of an inch from the live copy limit." Again, neither of these limitations are suggested by Silverbrook.

Claim 67: Claim 67 recites " a top **flat** edge measuring about 3 3/8 inches with a **protrusion** extending no more than about 1/2 of an inch and **at least 1/8 of an inch** away from the top edge" (emphasis added). The Office Action cites FIG. 3 of Biller as teaching this limitation (Office Action, p. 12, ll. 1-2). But FIG. 3 of Biller does not have a top flat edge; it is curved. Also, Biller cannot be relied upon to teach the dimensions set forth in the claims, as there is no suggestion that the disk of the figure comprises the claimed dimensions.

Applicants respectfully submit that independent claims 1, 12, 23, 35, 36, and 67 are allowable for at least the foregoing reasons. Claims 2-9, 12, 15-20, 24-30, 41-50, and 74-78 each depend from these independent claims, and are believed allowable for at least the same reasons as given above. Applicants respectfully request that the rejections to the claims under 35 U.S.C. §103(a) be withdrawn.

35 U.S.C. §102 Rejection

The Office Action rejected claim 31 under 35 U.S.C. §102(e) as being anticipated by the cited portions of Blank. Claim 31 is amended to recite that the data card includes a live

copy limit that is within about 3/32 of an inch from the bottom and sides of the rectangular portion of the card. This limitation is quite similar to limitations of the remaining independent claims, and is absent from Blank.

In light of the foregoing, Applicants respectfully submit that independent claim 31 is allowable. Claims 33 and 34 each depend from claim 31, and are believed allowable for at least the same reasons as given above. Applicants respectfully request that the rejections to the claims under 35 U.S.C. §§102(e) and 103(a) be withdrawn.

35 U.S.C. §112 Rejection and Informalities

The Office Action objected to claims 1, 11, 23, 35 and 36 because of informalities, and rejected claims 67 and 74-78 under 35 U.S.C. §112 as failing to comply with the written description requirement. Claims 1, 11, 23, 35 and 36 are amended to address the informal objections. Regarding claim 67, it is respectfully suggested that the dimensions set forth in the Specification, specifically with reference to Figs. 10A-10L, teach the claimed dimensions (Original Application, p. 11, ll. 8-25). Applicants respectfully request that the rejections be withdrawn on these grounds as well.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 10/665,984
Amdt. dated August 31, 2006
Reply to Office Action of June 7, 2006

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "MLD:klb", written over the printed name.

Michael L. Drapkin
Reg. No. 55,127

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
MLD:klb
60819803 v1